

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:
Rodolfo M. PELZ et al.

For: SERVICE ELEMENT IN
DISTRIBUTED SYSTEMS

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Examiner: Jeffrey R. West

Art Unit: 2857

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Signature: /Aaron Grunberger/
Aaron Grunberger (Reg. No. 59,210)

REPLY BRIEF UNDER 37 C.F.R. § 41.41

SIR:

Appellants submit the present Reply Brief in response to the Examiner's Answer dated December 31, 2009.

For the reasons set forth in the Appeal Brief and those set forth below, it is again respectfully submitted that the final rejections of claims 11, 12, 14, 16 to 23 and 26 should be reversed.

Claims 1 to 10, 13, 15, 24, and 25 have been canceled. Claims 11, 12, 14, 16 to 23 and 26 have been finally rejected.

Appellants incorporate herein arguments previously presented in the Corrected Appeal Brief dated September 11, 2009. In addition, the following comments are presented to further highlight the differences between the claimed subject matter and the applied prior art references.

Claims 11, 12, 14, and 16 to 23 stand finally rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

“The Examiner asserts that claims 11 and 19 are not sufficiently enabled because they each require both ‘performing an error diagnosis of software running on the other components’ and ‘allowing a remote diagnosis of the other components of the distributed system to be carried out, wherein the remote diagnosis includes testing at least one of the other components.’” Examiner Answer at page 28. As noted in MPEP § 2164.01, “[t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *United States v. Teletronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). The Examiner’s Answer states that “it is unclear to one having ordinary skill in the art whether the discussed testing of the new software version for errors is with reference to the claimed” error diagnosis or remote diagnosis. Respectfully, this fails to apply the proper standards for an enablement rejection. Since a person of ordinary skill in the art would be able to implement both an error diagnosis and a remote diagnosis without undue experimentation, the claims are sufficiently enabled. To the extent the Examiner is actually presenting an indefiniteness argument, with regard to the “unclear” application of the specification to the claim features, Applicants respectfully disagree, as the claims are quite clear.

The Examiner’s rejection is not based on a person of ordinary skill in the art’s inability to understand the claim features, but rather a perceived ambiguity as to which claim features certain sections of the specification describe and to how each feature is distinct. The specification at page 5, lines 17 to 20, makes the distinctions quite clear by reciting: “[s]ervice element 2 also contacts the service provider . . . when service element 2 can no longer eliminate an error itself. If the component in question can also no longer be repaired using the remote diagnosis of the service provider, then the service provider contacts the user of the distributed system . . . in order to request that he or she visit a repair shop.” From this section of the specification, there are clearly several distinct steps occurring. (1) “[W]hen service element 2 can no longer eliminate an error itself,” refers to a preceding step of the feature “performing an error diagnosis of software running on the other components, and, if the software on one of the other components has an error, correcting that software.” (2) “If the component in question can also no longer be repaired using the remote diagnosis of the service provider,” refers to the feature “allowing a remote diagnosis of the other components of the distributed system to be carried out, wherein the remote diagnosis includes testing at least one of the other components.” The implementation of these claim features would not

require undue experimentation for a person of ordinary skill in the art, and each one is distinctly supported in the present specification. Paraphrasing, the Specification clearly recites (1) a service element to find and fix component errors, (2) responsive to an inability to fix an error, allowing a remote diagnosis by a service provider, via the service element, including a component test, (3) fixing the issue or requesting the customer come in for repair; which is generally recited, in part, in the features of claim 11.

Claim 19 recites at least features substantially similar to claim 11, and thus the same supporting disclosure and arguments apply. Claims 12, 14, 16 to 18, and 20 to 23 are rejected by virtue of their dependencies from one of claims 11 or 19, and are therefore allowable for at least the same reasons as claim 19.

Reversal of this rejection is therefore respectfully requested.

Claim 26 stands finally rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

A person of ordinary skill in the art would know, based on the present disclosure, that Applicants had possession of the claim features. As was previously discussed, the specification describes, as one example embodiment, a service element to (1) diagnose and fix problems locally, (2) facilitate remote diagnosis and repair when local repair fails, and (3) request the user come in for service when remote repair fails. The Examiner's Answer cites page 7 of the specification, at lines 21 to 32, which generally describes one example embodiment including features (2) and (3) above, as evidence that claim 26 is unsupported, since claim 26 recites features supported by (1) and (2) above. This, however, is wholly irrelevant to the § 112 rejection of claim 26. Even if one portion of one example embodiment may not cover every claimed feature of a particular claim (e.g., 26), that does not render the claim new matter in violation of the written description requirement.

Claim 26 recites (A) automatically, and at predefined intervals, performing an error diagnosis of software running on the other components. This is fully supported on page 7, lines 6 to 8 of the present specification, as acknowledged by the Examiner at page 34 of the Examiner's Answer. Claim 26 also recites (B) for each of a first subset of errors diagnosed in the error diagnosis step, repair the error. This is fully supported on page 7, lines 12 and 13, which states: "if the remaining software of the service element has the independent capability, then the software can be repaired." Also, page 5, line 17 describes what happens after "service element 2 can no longer eliminate an error itself." Claim 26 also recites (C) for each of a second subset of errors diagnosed in the error diagnosing step, contact a provider and allow the provider to responsively remotely repair the error. See page 5, lines 13 to 17,

which states: “when service element 2 can no longer eliminate an error itself” it “contacts the service provider,” and “allows a service provider to carry out a remote diagnosis of the individual components.”

As the present specification clearly provides support, such that a person of ordinary skill in the art would understand Applicants had possession of these features at the time of filing, Applicants respectfully request reversal of this rejection.

Reversal of this rejection is therefore respectfully requested.

Claims 11, 12, 14, 17 to 20, and 23 stand finally rejected under 103(a) as being unpatentable over Razavi, in view of de Bellefeuille.

Neither reference discloses “performing an emergency function,” as required in the context of claim 11. The Examiner’s argument, as presented in the Examiner’s Answer at pages 38 to 39, may be summarized as: (1) “Razavi discloses an easily-upgradeable vehicle component architecture,” (2) “Razavi explicitly discloses the well-known prior art services of ‘computerized maps, navigation aids and emergency assistance signaling,’” and (3) “Razavi explicitly discloses that the entire purpose [of] Razavi is to improve upon the prior art system.” However, this is insufficient to sustain a *prima facie* case of obviousness, because Razavi does not disclose or suggest “performing an emergency function” as part of the “easily-upgradeable” architecture. Even if the cited portions of Razavi rendered obvious an “easily-upgradeable” architecture that included prior art functions, there is no basis to assume “performing an emergency function” would be an obvious combination for the Razavi system.

As previously argued, and left unaddressed in the Examiner’s Answer, the **only** reference to “emergency” in Razavi is a general recitation of the state of the automobile art in the background section, such as “providing computerized maps, navigation aids and emergency assistance signaling.” Even if prior art hazard lights disclose “performing an emergency function,” there is no basis to assume such a simple, mechanical device would produce any benefit or provide any reason to be replaced by the component architecture of Razavi. In fact, as the Examiner notes on page 41 of the Answer, “Razavi explicitly discloses that these services being provided to the user as part of the easily-upgradeable vehicle component architecture include the well-known prior art ‘computerized maps’ and ‘navigation aids.’” Despite this, Razavi omits from this disclosure “and emergency assistance signaling.” Computerized maps and navigation aids may present reasons to integrate those functions with Razavi’s component architecture, as they are display, memory, update, and processing intensive. Hazard lights, such as is disclosed in the background

section, present no such reasons to integrate with a system designed to be “easily-upgradeable.” The clear omission of this function, despite the inclusion of other functions as noted by the Examiner, is evidence of non-obviousness, as Razavi implies that there is no reason to combine the component architecture with “emergency assistance signaling.”

Razavi simply does not disclose “performing an emergency function” with the described component architecture. There is no basis to conclude, as the Examiner does on page 42, that “one having ordinary skill in the art would clearly recognize that the invention of Razavi discloses a system that replaces the prior art service, including the emergency assistance signaling, with the easily-upgradeable, processor-controlled components,” when in fact, Razavi implies the exact opposite by omitting “emergency assistance signaling” – a feature that requires absolutely no updates beyond a physical bulb replacement – from the list of prior art functions that may be included in a system specifically designed to facilitate upgrades.

Further, on page 43 of the Examiner’s Answer, the Examiner asserts that the various functions of Razavi at col. 2, lines 18 to 34 and col. 6, line 58 to col. 7, line 7 present other functions that may be considered “performing an emergency function.” However, there is simply no basis to conclude anything “such as microphones, cameras, GPS receivers, interfaces to on-board diagnostic systems, communication devices, displays, CD players, radios, speakers, security devices and LANs” or “traffic information” constitute “performing an emergency function.”

Independent of the above, Razavi does not disclose “a processing device disposed in the motor vehicle and adapted to perform operations including the operations of: configuring the other components; maintaining the other components; . . .” With respect to this feature, the Examiner cites Applicants response filed January 15, 2008 as allegedly “admitt[ing] that upgrading and maintaining are equivalent.” For the record, Applicants made no such admission. Regardless, the assertion is wholly irrelevant to the arguments presented in the present Appeal Brief.

Razavi may disclose that “compute platform 22 is at the center of in-car sub-network 20,” but nowhere does Razavi disclose “a processing device disposed in the motor vehicle and adapted to perform operations including the operations of: configuring the other components; [and] maintaining the other components; . . .” Razavi fails to disclose the present features for at least two reasons. First, Razavi states that devices are connected to the compute platform directly or via a network (e.g., Ethernet). Therefore, the GPS may be directly connected to the modem, indirectly connected to the compute platform via a network, and perform this “upgrade” directly with the modem (i.e., with no involvement from the

compute platform). Second, even if one assumes all devices are directly connected to the compute platform, Razavi only refers to that which is “conveyed through the network.” Conveying data is the function of a switch or router, and does not constitute “maintaining” or “configuring” the device to which data is merely conveyed.

Reversal of this rejection is therefore respectfully requested.

Claim 16 stands finally rejected under 103(a), as being unpatentable over Razavi, in view of de Bellefeuille, and in further view of Chou.

Claim 21 stands finally rejected under 103(a), as being unpatentable over Razavi, in view of de Bellefeuille, and in further view of Boatwright.

Claim 22 stands finally rejected under 103(a), as being unpatentable over Razavi, in view of de Bellefeuille, and in further view of Ishii.

The rejections of these claims have been maintained without further comment, and Appellants rely on the previously presented arguments.

Claim 26 stands finally rejected under 103(a) as unpatentable over Razavi, in view of de Bellefeuille, in further view of Chou, and in further view of Ishii.

No substantive 35 U.S.C. § 103(a) rejection has been made for the claim features “for each of a first subset of errors diagnosed in the error diagnosis step, repair the error; and for each of a second subset of errors diagnosed in the error diagnosing step, contact a provider and allow the provider to responsively remotely repair the error.” These features were rejected under § 112, but no § 103(a) reasoning has been provided. The current § 103(a) rejection only addresses the feature of “automatically, and at predefined intervals, performing an error diagnosis of software running on the other components.” *See e.g.*, Final Office Action of October 29, 2008 at page 16 and 17. Thus, to the extent claim 26 recites unique features, the Examiner has relied exclusively on the § 112 rejections, which have been addressed above. Since the Examiner has not provided a substantive § 103 rejection of these features, it is assumed that they are novel and nonobvious. Further, for the reasons previously discussed, the features are definite, supported, and enabled. Thus, Applicants respectfully request the § 103 rejection of claim 26 be reversed.

Claims 11, 12, 14, 16 to 21, and 23 stand finally rejected under 103(a) as being unpatentable over Gray, in view of Buckley, and in further view of Chou.

With respect to claim 11, Gray may generally describe a control center device connected to other devices, where the control center device includes a software interface

(within the control center device) that is used by the control center device to communicate with an associated other device. It is this interface, within the control center device, that is upgraded/maintained. “The Examiner asserts that one having ordinary skill in the art would clearly recognize that providing a processing device that updates new interfaces [stored and used *in* the processing device] for the other components that allow the other components to maintain interaction, communication, and control by/with the processor . . . meets the limitation of ‘a processing device disposed in the motor vehicle and adapted to perform operations including the operations of . . . maintaining the other components.’” Examiner Answer at page 58. However, this is clearly incorrect, as a person of ordinary skill in the art would recognize that updating (or maintaining) interface software of a central processing device *does not* disclose “maintaining the other components.”

Further, neither Gray nor Buckley discloses “the remote diagnosis includes testing at least one of the other components,” and the Examiner relies on Chou at col. 3, lines 15-31 and col. 5, lines 34-35. However, the remote service center 200 (including diagnostic server 201) is thoroughly discussed at Chou col. 5, line 33 to col. 6, line 47, and does not mention “wherein the remote diagnosis includes testing at least one of the other components.” “Diagnostic server 201 [may have] access to data related to the vehicle such as history, as-built, diagnostics, warranty, service information and failure mode data.” Chou, col. 5, lines 35-37. The section goes on to further describe data collection and modeling, but nowhere does Chou disclose a “remote diagnosis [that] includes **testing** at least one of the **other** components.” The Examiner quotes Applicants’ Appeal Brief as stating that “diagnosis/testing is known in the art,” and Applicants maintain that both diagnosis and testing are known in the art, but specific steps are dependent on the specific implementation.

The Examiner acknowledges that Applicant[s] argue[] the merits of ‘testing’ and indicates that while Chou discloses a ‘diagnostic server,’ Chou does not specifically teach that such diagnosis includes testing. As clearly indicated by the sections of Chou cited in the Examiner’s Answer, *see* pages 61 and 62, the “diagnosis” of Chou is merely data collection, with no indication that a single test is performed on other components. Thus, to the extent Chou describes a diagnosis, the reference fails to disclose the features of claim 11, which include “wherein the remote diagnosis includes testing at least one of the other components.”

Claim 19 recites at least features substantially similar to claim 11 and is therefore allowable for at least essentially the same reasons as claim 11.

Dependent claims 12, 14, 16 to 18, 20, 21, and 23 are also allowable for at least the same reasons as their respective base claims.

Reversal of this rejection is therefore respectfully requested.

Claims 22 and 26 stand finally rejected under 103(a), as being unpatentable over Gray, in view of Buckley, in view of Chou, and in further view of Worger.

Claim 22 depends from claim 11 and as discussed above, Gray, Buckley and Chou do not describe or suggest all of the features of claim 11. Worger does not cure those deficiencies of Gray, Buckley and Chou (nor has it been relied on for such). Accordingly, the combination of Gray, Buckley, Chou, and Worger does not render unpatentable claim 22.

Claim 26 recites features substantially similar to the above argued features of claims 11 and 19, for which the combination of Gray, Buckley, and Chou are insufficient as discussed above. Worger does not cure those deficiencies of Gray, Buckley and Chou (nor has it been relied on for such). Accordingly, the combination of Gray, Buckley, Chou, and Worger does not render unpatentable claim 26.

Reversal of this rejection is therefore respectfully requested.

For at least the reasons indicated above, Appellants respectfully submit that the relied upon references do not disclose, or even suggest, Appellants' invention as recited in the claims of the above-identified application. Accordingly, it is respectfully submitted that the inventions recited in the claims of the present application are new, non-obvious, and useful.

For the foregoing reasons and for the reasons more fully set forth in the Appeal Brief, it is respectfully submitted that the final rejections of the pending claims should be reversed.

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Respectfully submitted,
/Aaron Grunberger/
By: Aaron Grunberger (Reg. No. 59,210) for:
Gerard A. Messina
Registration No. 35,952

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646